REMARKS

Applicant has carefully reviewed the Office Action mailed August 4, 2006 and offers the following remarks.

Claims 1-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,529,992 B1 to Thomas et al. (hereinafter "Thomas") in view of U.S. Patent No. 6,055,314 to Spies et al. (hereinafter "Spies"). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). If the Patent Office cannot establish obviousness, the claims are allowable.

Before addressing the rejections, Applicant provides a brief overview of the invention as background. The present invention relates to a portable device configured to interact with any number of host computing devices. The portable device primarily includes memory associated with an interface to facilitate interaction with the host computing devices. The portable device may include control circuitry to assist in interactions with the host computing devices, as well as to execute software and organize data stored thereon.

In operation, the portable device will initially appear to a host computing device as a known device type. The host computing device will be configured to interact with the portable device as the known device type. Upon such interaction, the host computing device will access indicia sufficient to identify the portable device as a second device type and instruct the host computing device to configure itself to interact with the portable device as the second device type. The second device type is preferably configured to provide a service for applications running on the host computing device. In a preferred embodiment, the second device type is a cryptographic service provider (CSP) capable of providing cryptography services for applications running on the host computing device. Notably, portable devices equipped with processing capabilities may operate to provide processing for the services provided by the second device type on the portable device.

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First, Applicant traverses the rejection because the Patent Office has not properly supported the proposed combination. The Patent Office asserts that it would have been obvious to combine Thomas with Spies "because configuring the host computer to run the applications from the portable device allows a user to maintain everything he or she needs, while using a portable disk (see col. 4, lines 8-16 of Thomas et al.). The added benefit of cryptography services provided to the host computing device allows an end-to-end encryption of data to ensure all data is stored encrypted (see col. 3, lines 5-63 of Spies et al.)" (Office Action mailed August 4, 2006, p. 4). Applicant initially notes that this is the exact same motivation asserted by the Patent Office in the previous Office Action to combine Thomas and McCown (see Office Action mailed February 2, 2006, p. 4). This indicates that the Patent Office has failed to provide an independent analysis and provide actual evidence to support a proper combining of Thomas and Spies.

In fact, just as the previous motivation, this alleged motivation to combine Thomas and Spies is faulty and lacks actual evidence. The first sentence of the Patent Office's alleged motivation to combine merely states that Thomas discloses a removable disk which contains application software to be run on a PC, which allows a user to maintain what he or she needs on the removable disk. The second sentence of the proposed motivation simply states that Spies discloses cryptography services. What is lacking in the Examiner's alleged motivation is why one of ordinary skill in the art looking at the system of Thomas would be motivated to look to the cryptography services of Spies; in fact, the Patent Office has failed to even indicate why Thomas would need encryption or cryptography services. In addition, Thomas and Spies are directed to totally different fields. Thomas relates to a removeable computer disk containing computer application software. Spies is directed to the secure purchase and delivery of video content. One or ordinary skill in the art of computer application software would not look to a reference like Spies that deals with the secure purchase and delivery of video content. Moreover, the Examiner has failed to support the alleged motivation to combine with any actual evidence, as is required by Federal Circuit law. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Since the stated motivation to combine Thomas and Spies is faulty and lacks the requisite actual evidence, the stated motivation is improper. Since the stated motivation is improper, the proposed combination is improper. Since the proposed combination is improper, and the

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references individually do not teach or suggest each and every element of the claims, the claims are patentable.

Even if the proposed combination is proper, a point Applicant does not concede, the combination does not teach or suggest each and every element of the claimed invention. Claim 1 recites a portable device with memory containing "initial identification indicia to initially identify the portable device to the host computing device as a first device type, which is known to the host computing device" and "configuration indicia to subsequently identify the portable device to the host computing device as a second device type and provide configuration instructions to allow the host computing device to effectively interact with the portable device as the second device type." The claim also recites "wherein the host computing device will detect the portable device as being the first device type and subsequently configure itself to interact with the second device type, wherein the second device type is a cryptographic service provider." The Patent Office cites Thomas as teaching the first element of "initial identification indicia to initially identify the portable device to the host computing device as a first device type, which is known to the host computing device," but admits that Thomas fails to teach "configuration indicia to subsequently identify the portable device to the host computing device as a second device type and provide configuration instructions to allow the host computing device to effectively interact with the portable device as the second device type" and "wherein the host computing device will detect the portable device as being the first device type and subsequently configure itself to interact with the second device type, wherein the second device type is a cryptographic service provider." (Office Action mailed August 4, 2006, p. 3) The Patent Office cites to Spies as allegedly teaching the elements missing from Thomas. Applicant respectfully traverses.

Claim 1 recites that the portable device contain indicia that will initially identify the portable device to the host computing device as a first device type that is known to the host and different indicia that will subsequently identify the portable device to the host as a second device type (a cryptographic service provider), such that the host computing device will detect the portable device as being the first device type and subsequently configure itself to interact with the second device type (a cryptographic service provider). Although Spies teaches an IC card (a smart card) that contains cryptography services for viewing copyrighted video materials, Spies, alone or in combination with Thompson, fails to teach a single portable device that contains: (1)

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initial identification indicia to initially identify the portable device to the host computing device as a first device type, which is known to the host computing device and (2) configuration indicia to subsequently identify the portable device to the host computing device as a second device type and provide configuration instructions to allow the host computing device to effectively interact with the portable device as the second device type, such that the host computing device will detect the portable device as being the first device type and subsequently configure itself to interact with the second device type, wherein the second device type is a cryptographic service provider. In other words, although the IC card of Spies is meant to provide cryptography services; it does not initially identify itself to the host as a first device type and then provide configuration instructions to allow the host to interact with the portable device as a second type (the cryptographic service provider). Spies only teaches a portable device having a single device type, a cryptography service provider. In particular, Spies teaches an IC card that provides cryptography services, but does not initially identify the portable device to the host computing device as a first device type, which is known to the host computing device and is not the cryptography service provider. Even if combined with Thomas, the combination would not teach or suggest a single portable device that contains (1) initial identification indicia to initially identify the portable device to the host computing device as a first device type, which is known to the host computing device and (2) configuration indicia to subsequently identify the portable device to the host computing device as a cryptographic service provider, such that the host computing device will detect the portable device as being the first device type and subsequently configure itself to interact with the second device type (a cryptographic service provider). Neither Thomas nor Spies mentions the host computing device detecting a portable device as a known first device type and then subsequently configuring itself to interact with the portable device as a cryptographic service provider. Thus, since the references alone do not teach this element, the combination cannot teach the element.

Based on the above discussion, the combination of Thomas and Spies does not teach or suggest each and every element of claim 1. Claim 1 is therefore patentable. Independent claims 13 and 23 have similar limitations as claim 1, and are therefore patentable for at least the same reasons as claim 1.

Claims 17 and 22 contain limitations similar to those in claim 1, and are patentable for at least the same reasons set forth above with respect to claim 1. However, claims 17 and 22 are
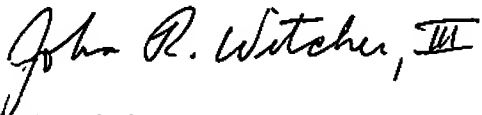
slightly different from claim 1. Claim 17 includes the limitations "identifying a portable device to a host computing device as a first device type, which is known to the host computing device"; "registering the portable device with host computing device as the first device type"; "automatically identifying the portable device to the host computing device as a second device type"; and "enabling the portable device as the second device type with the host computing device based on information provided on the portable device." Claim 22 is a method claim and is similar to claim 17, with claim 22 specifically claiming a cryptographic service provider as the second device type. As discussed above, the combination of Thomas and Spies fails to teach or suggest where a portable device is identified to the host computing device as a first device type and then is subsequently identified as a second device type. In addition, neither Thomas nor Spies, alone or in combination, teach or suggest where the identifying the portable device as a second device is **automatic**. The Patent Office cites to Figure 6, element 104, to col. 11, line 64 through col. 12, line 1, and to col. 12, lines 41-44 as allegedly teaching "automatically identifying the portable device to the host computing device as a second device type" (Office Action mailed August 4, 2006, p. 8). Applicant has reviewed the cited portions of Spies. First of all, although Spies does disclose an IC card that when coupled to a viewer computing unit, cooperates to form a video decryption device, there is no mention of identifying the IC card as two different device types. In addition, there is no teaching or suggestion that the IC card is **automatically** identified as a second device type, as required by claims 17 and 22. Thus, for at least these reasons, claims 17 and 22 are patentable.

Claims 2-7, 9-11, and 24-26 depend from claim 1 and contain all the limitations of claim 1. Therefore, claims 2-7, 9-11, and 24-26 are patentable for at least the same reasons as set forth above with respect to claim 1. Claims 14-16 depend from claim 13 and are allowable for at least the same reasons as claim 13. Claims 18-20 depend from claim 17 and contain all the limitations of claim 17. Therefore, claims 18-20 are patentable for at least the same reasons as set forth above with respect to claim 17.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

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Respectfully submitted,

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